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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/598,060	06/20/2000	Bernhard Kraus	1826-015	5495

7590 01/24/2002

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EXAMINER

GUADALUPE, YARITZA

ART UNIT

PAPER NUMBER

2859

DATE MAILED: 01/24/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/598,060

Applicant(s)

KRAUS ET AL.

Examiner

Yaritza Guadalupe

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) 10-12 and 21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 and 13 - 20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3 and 5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1 – 9 and 13 - 20, drawn to an apparatus.

II. Claims 10 – 12 and 21, drawn to a method.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions II and I are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the apparatus as claimed can be use to practice another materially different method that does not requires the parameters and particular formula disclosed in the method claims.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

4. During a telephone conversation with Mr. James Bollinger on January 11, 2002 a provisional election was made with traverse to prosecute the invention of Group I, drawn to an apparatus, claims 1 – 9 and 13 - 20. Affirmation of this election must be made by applicant in replying to this Office action. Claims 10 – 12 and 21 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

*Claim Rejections - 35 USC § 102*

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

7. Claims 1, 4 – 5 and 14 – 16 are rejected under 35 U.S.C. 102 ( b ) as being anticipated by DeFrank et al. ( US 5,066,142 ).

DeFrank et al. discloses a radiation thermometer comprising an infrared sensor ( See Column 3, lines 18 – 19 ) and a probe tip / head ( 16 ) including a radiation inlet opening ( 22 ) enabling infrared radiation to travel from a measurement site to the sensor. DeFrank et al. discloses a probe tip / head that in a broad sense is considered to be demountably attachable to

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the thermometer. DeFrank et al. discloses an opening for infrared radiation, which is closed by a window ( 22 ) transparent to infrared radiation. DeFrank et al. also discloses a switch ( 44 ) actuatable when the tip / cover is installed and that the temperature indication / calculation from the measurements is influenced by the actuation of the switch ( See Column 5, lines 41 – 55 ).

8. Claims 1 – 3, 6, 9, 13, 17 and 20 are rejected under 35 U.S.C. 102 ( e ) as being anticipated by Pompei ( US 6,047,205 ).

Pompei discloses a radiation detector probe comprising an infrared sensor ( 28 ) and a probe tip / head ( 18 ) including a radiation inlet opening ( 31 ) enabling infrared radiation to travel from a measurement site to the sensor. Pompei discloses a probe tip / head that in a broad sense is considered to be demountably attachable to the thermometer. Pompei discloses the probe tip / head being pivotal in at least one spatial plane ( See Figure 2 and Column 5, lines 14 – 17 ). Pompei discloses an opening for infrared radiation which is closed by a window ( 35 ) transparent to infrared radiation. Pompei discloses the geometrical shape of the probe head being selected so that the measurement site is shielded from the environment.

With respect to the term “demountably attachable” in claims 1 and 2 : the term “demountably attachable” do not structurally distinguish the claimed invention from Pompei. Furthermore, in a broad sense, any structure may be considered to be “demountably attachable”, if so desired as long as the structure may be demountably attachable by any means, if so desired.

*Claim Rejections - 35 USC § 103*

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 7 - 8 and 18 - 19 are rejected under 35 U.S.C. 103 ( a ) as being unpatentable over Pompei ( US 6,047,205 ) in view of Pompei et al. ( US 5,893,833 ), and further in view of European Patent ( 411,121 A1 ) [ Hereinafter EP ].

Pompei discloses a radiation probe as stated in paragraph 8 above.

Pompei does not disclose the funnel-shaped configuration as stated in claims 7 – 8 and 18 - 19.

With respect to claims 7 – 8 and 18 - 19 : Pompei et al. ('833) discloses a probe tip / head comprising a funnel – shaped configuration. Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to change the shape of the probe tip / head disclosed by Pompei with a funnel – shaped tip / head as taught by Pompei et al. ('833) in order to enhance the measurements by increasing the area of heat transfer and since the use of a funnel – shape on the probe tip / head is only considered to be an obvious modification of the shape or configuration of the probe tip / head shape disclosed by Pompei as the courts have held that a change in shape or configuration, without any criticality, is within the level of skill in the art as the particular shape claimed by Applicant is nothing more than one of numerous shapes that a person having ordinary skill in the art will find obvious to provide using routine experimentation based on its suitability for the intended use of the invention. See In re Dailey, 149 USPQ 47 ( CCPA 1976 ).

However, EP discloses a thermometer having a tip / head ( 12 ) having a size and shape conforming to the cavity, i.e., ear, or oral cavity, ( See Column 6, lines 36 – 39 ). In a broad sense, EP implicitly teaches the option of providing a plurality of configurations, i.e., geometrical shape and funnel – shaped, for the probe tip / head in order to fit the probe to the measurement site. Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to provide a probe tip / head having a geometrical shape selected to fit the measurement site as taught by EP in the radiation probe disclosed by Pompei



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and Pompei et al. ('833) in order to enhance the device by providing a painless alternate mechanism that fit to every patient kids and adults.

### *Conclusion*

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Beerwerth et al. ( US 6,152,595 ) discloses a radiation thermometer comprising a tip / head ( 10 ), and an inlet opening having a window / filter ( 34 ). Beerwerth et al. (US 6,149,297) discloses an infrared radiation thermometer comprising a probe tip / head ( 2 ) having a cover ( 5, 6 ), an inlet having a window / filter ( 4 ), and an electric switch to allow evaluation when indication of the cover being in position is obtained ( See Column 5, lines 35 – 43 ). Pompei et al. ( US 5,893,833 ) discloses an infrared thermometer comprising a probe tip / head ( 44, 35 ), and an inlet window ( 34 ). Fraden ( US 6,152,596 ) discloses an infrared thermometer comprising a probe having a tip / head ( 5 ), a probe cover ( 11 ), and probe inlet window ( 15 ). Mooradian et al. ( US 5,871,279 ) discloses a tympanic probe comprising a probe ( 214 ), a window ( 206 ), and a tip / head ( 216 ). DeFrank et al. ( US 6,332,090 B1 ) discloses a device having a thermometer / probe ( 10 ), a switch ( 14 ), a wave-guide for radiation ( 18 ), and a window ( 22 ).

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yaritza Guadalupe whose telephone number is (703)305 -5676. The examiner can normally be reached on 9:00 AM - 6:30 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diego F.F. Gutierrez can be reached on (703) 308-3875. The fax phone numbers for the organization where this application or proceeding is assigned are (703)308-7722 for regular communications and (703)308-7722 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0956.



Y. Guadalupe  
January 22, 2002

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